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| 10/824,165 | 04/14/2004 | Timothy J. Kardosz | ERN-TSH-001 | 6340 |
| 25784 7590 10/14/2008 MICHAEL O. SCHEINBERG P.O. BOX 164140 AUSTIN, TX 78716-4140 | | | | |
| EXAMINER WALTERS, RYAN J | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/824,165

Applicant(s)

KARDOSZ ET AL.

Examiner

RYAN J. WALTERS

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 21-25 is/are pending in the application.
4a) Of the above claim(s) 1-12 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 21-25 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 14 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date 8/10/2004, 11/24/2004
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of a method of making a truss (Claims 21-25) in the reply filed on 8/4/2008 is acknowledged. The traversal is on the ground(s) that because the claims deal with similar subject matter in a narrow field, there would not be a serious burden on the Examiner if restriction is not required. This is not found persuasive because invention I (Claims 1-12) is distinct from invention II (Claims 21-25) since they have a materially different mode of operation where the step of generating data in order to produce stud members is required for invention I but is not required for invention II. Further, the inventions have acquired a separate status in the art in view of their different classification. There would be a serious search and examination burden on the examiner if restriction were not required for the reasons stated above.

The requirement is still deemed proper and is therefore made FINAL.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following **reference character(s) not mentioned in the description: 180 (Fig. 1B)**. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing

date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities:

-On page 5, paragraph 17, line 10: Replace "jib" with -jig--.

-On page 7, paragraph 20, line 4: Replace "wile" with -while--.

Appropriate correction is required.

Claim Objections

4. Claim 24 is objected to because of the following informalities:

-Claim 24 recites "...using a roll-forming machine including forming on the roll-forming machine an assembly tag..." The examiner is assuming that the assembly tag is formed on the stud and not on the roll-forming machine. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the **second paragraph of 35 U.S.C. 112**:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 21-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Claim 21 recites the limitations "the first "C" channel data" and "the second "C" channel data". There is insufficient antecedent basis for these limitations in the claim. It appears that the term "data" should be deleted.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. **Claims 21-23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Buers (US 5,715,642).**
10. In regards to **Claim 21**, Buers discloses a method of making a truss 98 using back-to-back "C" channel studs without requiring the use of a jig (Fig. 6; Col. 3, lines 1-10), comprising: forming a first and second "C"-channel stud 60 using a roll-forming machine (Col. 9, lines 58-65), the "C" channel studs 60 including a web 62, a flange 64, and a lip 68 (Col. 7, lines 44-58); forming, using the roll-forming machine in the first "C" channel, a first alignment feature 72, and in the second "C" channel, a second alignment feature 72 (Col. 9, lines 58-65; Col. 7, lines 55-58); juxtaposing the first and second "C"-channel studs 60 back-to-back with the web 62 of the first "C"-channel stud 60 contacting the web 62 of the second "C"- channel stud 60 such that the first and

second alignment feature 72 are aligned (Figs. 6, 7; Col. 12, lines 1-13); and attaching the first and second "C"-channel studs 60 to each other using fasteners (Fig. 7; Col. 12, lines 1-13), the alignment holes formed by the roll-forming machine providing a way for aligning and attaching the first and second "C"-channel studs 60 without requiring a jig (Fig. 7; Col. 12, lines 1-13; Col. 3, lines 1-10).

11. In regards to **Claim 22**, Buers discloses that the first alignment feature and the second alignment feature each comprises an alignment hole and in which juxtaposing the first and second "C"-channel studs 60 such that the first alignment feature 72 and the second alignment feature 72 are aligned includes inserting an item into the first and second alignment holes (Fig. 7; Col. 12, lines 1-13; Col. 4, lines 15-18).

12. In regards to **Claim 23**, Buers discloses attaching the "C"-channel studs to each other using self-drilling screws 120a, 120b, 124a, 124b (Fig. 7; Col. 4, lines 7-8 and 14-19).

13. In regards to **Claim 25**, see 120a in Fig. 7, which lies on the centerline of the stud.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buers (US 5,715,642).

17. In regards to **Claim 24**, as best understood, Buers discloses applying assembly tags on the studs which identify the size, gauge, and length of a piece (Col. 1, lines 38-40). Buers does not teach using a roll forming machine to form the assembly tags or that the assembly tags include information about assembling the stud to form the truss. However, the examiner is taking Official Notice that it is known in the art to apply labels or information on components identifying how to assemble components or where the components should be placed in relation to other components. Further, the instant application teaches that conventional roll forming machines (which are well known in the art) can print assembly tags onto a member as the member is being formed (Page 8, paragraph 23). Therefore, it would be obvious to one of ordinary skill in the art to provide information about assembling directly on the component in order to eliminate a need for a template or extensive instructions thus simplifying assembling procedures.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mulligan (US 2365579) teaches using dowels 28 to align truss members (Fig. 10; Page 3, Col. 1, lines 50-55). Jorgenson (US 3398853) teaches using dowels 27 to align two components which are to be drilled.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN J. WALTERS whose telephone number is (571)270-5429. The examiner can normally be reached on Monday-Thursday, 8am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on 571-272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. J. W./
Examiner, Art Unit 3726

/DAVID P. BRYANT/
Supervisory Patent Examiner, Art Unit 3726